

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

MMB Docket No. **1671-0299**

J & J Reference: **DEP5257USNP**

Confirmation No.: **7432**

Application of: **Bihary et al.**

Group Art Unit: **3775**

Serial No. **10/814,557**

Examiner: **Michael T. Shaper**

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James D. Wood

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Signature

November 16, 2009

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APPEAL BRIEF

Sir:

This is an appeal under 37 CFR § 41.31 to the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office from the rejection of the claims 1-11 and 20-30 of the above-identified patent application. These claims were indicated as rejected in an Office Action dated June 16, 2009. The \$540.00 fee required under 37 CFR § 41.20(b) (2) is submitted herewith. Also, please provide any extensions

of time that may be necessary and charge any fees that may be due to Account No. 13-0014, but not to include any payment of issue fees.

(1) REAL PARTY IN INTEREST

DePuy Products, Inc. of Warsaw, Indiana is the assignee of this patent application, and the real party in interest.

(2) RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences related to this patent application (serial no. 10/814,557).

(3) STATUS OF CLAIMS

Claims 1-11 and 20-30 are pending in the application.

Claims 12-29 are canceled.

Claims 1-11 and 20-30 are being appealed, and are shown in the Appendix attached to this Appeal Brief.

(4) STATUS OF AMENDMENTS

Appellants have not filed any amendment after receipt of the June 16, 2009 Office Action (the “Office Action”).

(5) SUMMARY OF CLAIMED SUBJECT MATTERClaim 1

A handheld instrument for insertion of an acetabular liner into an acetabular cup (See, e.g., Appellants' specification at page 7, lines 19-21 and reference number 20 of FIG. 5) comprising:

a shaft (See, e.g., Appellants' specification at page 7, lines 21-22 and reference number 22 of FIG. 5) having an internal channel therethrough (See, e.g., Appellants' specification at page 8, lines 27-28 and reference number 46 of FIG. 8) and a first and a second end portion, the first end portion configured to sealingly engage with a bulb syringe (See, e.g., Appellants' specification at page 9, lines 7-9 and FIG. 5);

a bulb syringe sealingly engaged with the first end portion of the shaft and operably connected to the internal channel of the shaft (See, e.g., Appellants' specification at page 9, lines 7-9, 21-24 and FIG. 5); and

a head portion (See, e.g., Appellants' specification at page 7, lines 22-23 and reference number 26 of FIG. 5) having a curvilinear outer perimeter configured to sealingly engage the inner surface of an acetabular liner (See, e.g., Appellants' specification at page 8, lines 12-20 and reference number 26 of FIG. 5) and operably attached to the second end portion of the shaft (See, e.g., Appellants' specification at page 9, lines 4-6 and reference numbers 36 and 44 of FIG. 8) and having an inner channel therethrough operably connected to the internal channel of the shaft (See, e.g., Appellants' specification at page 8, lines 10-12, page 9 lines 21-24, and reference numbers 38 and 46 of FIG. 8).

Claim 20

Claim 20 is an independent claim. Claim 20 recites:

A kit providing a handheld instrument for insertion of an acetabular liner into an acetabular cup (See, e.g., Appellants' specification at page 7, lines 19-21, page 8, lines 4-9 and reference number 20 of FIG. 5) comprising:

a shaft (See, e.g., Appellants' specification at page 7, lines 21-22 and reference number 22 of FIG. 5) having an internal channel therethrough (See, e.g., Appellants' specification at page 8, lines 27-28 and reference number 46 of FIG. 8) and a first and a second end portion, the first end portion configured to sealingly engage with a bulb syringe (See, e.g., Appellants' specification at page 9, lines 7-9 and FIG. 5), the second end configured to sealingly engage with a head; and

a plurality of heads (See, e.g., Appellants' specification at page 7, lines 22-23, page 8 lines 4-9 and reference number 26 of FIG. 5), each head having a curvilinear outer perimeter and configured to be operably attached to the second end portion of the shaft (See, e.g., Appellants' specification at page 9, lines 4-6 and reference numbers 36 and 44 of FIG. 8) such that an inner channel of the head connects to the internal channel of the shaft (See, e.g., Appellants' specification at page 8, lines 10-12, page 9 lines 21-24, and reference numbers 38 and 46 of FIG. 8), each of the plurality of heads having a curvilinear outer perimeter sized to at least partially fit within an acetabular liner (See, e.g., Appellants' specification at page 8, lines 12-20 and reference number 26 of FIG. 5).

Claim 25

Claim 25 is an independent claim. Claim 25 recites:

An instrument for insertion of an acetabular liner into an acetabular cup (See, e.g., Appellants' specification at page 7, lines 19-21 and reference number 20 of FIG. 5) comprising:

a shaft (See, e.g., Appellants' specification at page 7, lines 21-22 and reference number 22 of FIG. 5) having an internal channel therethrough (See, e.g., Appellants' specification at page 8, lines 27-28 and reference number 46 of FIG. 8) and a first and a second end portion, the first end portion configured to sealingly engage with a hand held vacuum producing device (See, e.g., Appellants' specification at page 9, lines 7-9 and FIG. 5); and

a head (See, e.g., Appellants' specification at page 7, lines 22-23 and reference number 26 of FIG. 5) having a curvilinear outer perimeter configured to abut a 360 degree portion of the inner surface of an acetabular liner (See, e.g., Appellants' specification at page 8, lines 12-20 and reference number 26 of FIG. 5) and operably attached to the second end portion of the shaft (See, e.g., Appellants' specification at page 9, lines 4-6 and reference numbers 36 and 44 of FIG. 8) and having an inner channel therethrough operably connected to the internal channel of the shaft (See, e.g., Appellants' specification at page 8, lines 10-12, page 9 lines 21-24, and reference numbers 38 and 46 of FIG. 8).

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1, 2, 4, 8, 11, 25-27, and 29-30 stand rejected under 35 USC §102(b) as being anticipated by U.S. Patent No. 5,896,886 of Wendt (hereinafter “Wendt”).

Claims 3 and 28 stand rejected under 35 USC §103(a) as being obvious over Wendt in view of U.S. Patent No. 3,723,995 of Baumann (hereinafter “Baumann”).

Claims 5-7 stand rejected under 35 USC §103(a) as being obvious over Wendt in view of U.S. Patent No. 6,620,132 of Skow (hereinafter “Skow”).

Claims 9 and 10 stand rejected under 35 USC §103(a) as being obvious over Wendt.

Claims 20-22 stand rejected under 35 USC §103(a) as being obvious over Wendt in view of U.S. Patent Publication No. 2005/0015059 of Sweeney (hereinafter “Sweeney”).

Claims 23-24 stand rejected under 35 USC §103(a) as being obvious over Wendt in view of Sweeney.

(7) ARGUMENT**Claims 1, 2, 4, 8, 11, 25-27, and 29-30 are not Anticipated**

Claims 1, 2, 4, 8, 11, 25-27, and 29-30 stand rejected under 35 USC §102(b) as being anticipated by Wendt. Wendt does not teach or disclose each element of the claims. Therefore, the rejections should be overturned.

Discussion re: Patentability of Claim 1

1. Claim 1

Claim 1 recites the following:

A handheld instrument for insertion of an acetabular liner into an acetabular cup comprising:

a shaft having an internal channel therethrough and a first and a second end portion, the first end portion configured to sealingly engage with a bulb syringe;

a bulb syringe sealingly engaged with the first end portion of the shaft and operably connected to the internal channel of the shaft; and

a head portion having a curvilinear outer perimeter configured to sealingly engage the inner surface of an acetabular liner and operably attached to the second end portion of the shaft and having an inner channel therethrough operably connected to the internal channel of the shaft.

Accordingly, claim 1 recites a device which seals with the internal surface of an acetabular cup.

1. The Preamble Has Been Ignored

The Federal Circuit has stated that “[i]f the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is ‘necessary to give life, meaning, and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the claim.” *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). The preamble of claim 1 is necessary to give life to the claim.

Specifically, the preamble of claim 1 specifies that the claimed system is “for insertion of an acetabular liner into an acetabular cup.” The entire specification is directed to the issue of how to provide for proper insertion of an acetabular liner given the constraints of a surgical environment. (See, e.g., Appellants’ specification at pages 2-4).

Thus, the preamble establishes the context for the meaning of the limitations set forth therein. Moreover, the body of the claim provides structural limitations that refer to the interface between the claimed instrument and an acetabular liner. For example, the head as recited in claim 1 is specifically required to “sealingly engage the inner surface of an acetabular liner.” Therefore, the instrument of claim 1 must be an instrument “for insertion of an acetabular liner into an acetabular cup.”

In contrast, the device of Wendt is configured to destroy an oil can so as to recover oil remaining therein. To this end, the device includes a “piercing jaw tooth” which punctures the oil can to allow oil to be recovered. (Wendt at column 3, lines 25-29). One of ordinary skill in the art would never intentionally “puncture” an acetabular liner when inserting the liner. As discussed at page 1 of the Appellants’ specification, the acetabular liner provides a bearing surface for the ball or femoral component of the joint. A bearing surface which has been punctured is unsuitable for use in an acetabular cup.

Anticipation under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Since Wendt does not disclose a device that could be used “for insertion of an acetabular liner into an acetabular cup,”

Wendt does not anticipate claim 1.

2. Examiner Has Failed to Properly Identify or Allege a Head in Wendt

The Examiner has rejected claim 1 based upon Wendt. (Office Action at page 3). The Examiner has failed, however, to identify any structure or disclosure in Wendt which could be considered to be a head as recited in claim 1 other than a vague reference to “figure 2). (See, e.g., Office Action at page 3).

Specifically, the Examiner has alleged that Wendt discloses “a head portion (see figure 2), which is capable of sealingly engaging the inner surface of an acetabular liner.” (Office Action at page 3). Figure 2, however, discloses the entire device of Wendt. Moreover, nothing in FIG. 2 of Wendt appears to be even remotely similar to the head 26 shown in Appellants’ FIG. 5. Likewise, nothing in figure 1 of Wendt is configured to sealingly engage the inner surface of a generally hemispherical object, which is the general shape of an acetabular liner.

37 CFR. 1.104 (c)(2) states

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

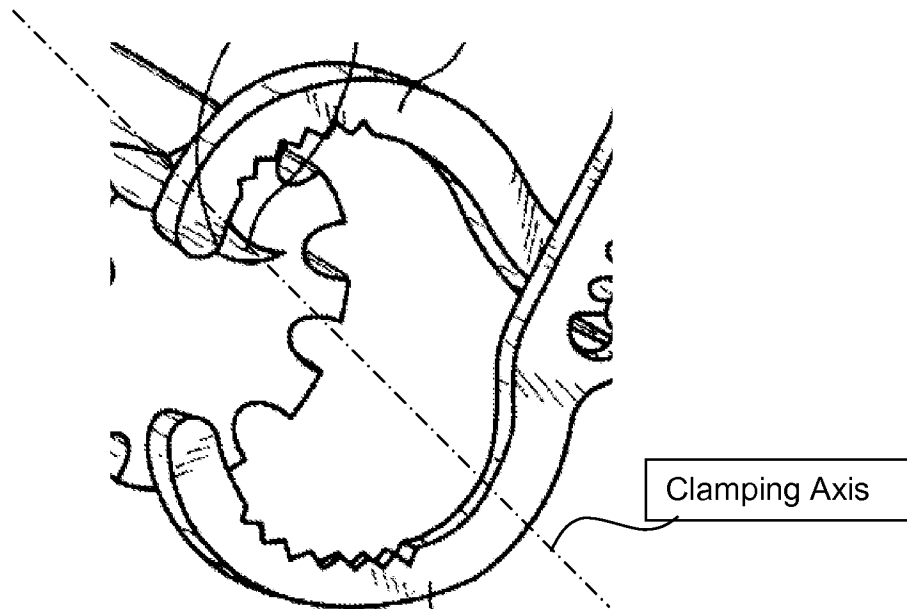
Because the Examiner failed to identify any structure in figure 2 which disclosed a “head”, and because the entire device of Wendt is shown in FIG. 2, the Examiner has failed to comply with 37 CFR 1.104.

Because the Examiner has failed to comply with the requirements of 37 CFR. 1.104 (c)(2), the rejection of claim 1 under 35 U.S.C. § 102 is improper. Accordingly, the Board of Appeals is respectfully requested to reverse the rejection of claim 1.

3. The Wendt Device is Not Arranged as Required by Claim 1

Even if one assumes *arguendo* that the Examiner alleged that Wendt disclosed a device that included all of the structural limitations of claim 1, the elements of Wendt are not arranged in the manner required by claim 1.

Specifically, claim 1 requires a head with an outer perimeter that sealingly engages the *internal* surface of an acetabular liner. Accordingly, the acetabular liner is maintained in position on the inserter by forces applied to the *internal* surface of the liner by the *outer* perimeter of the head. In contrast, the oil filter wrench of Wendt grips an oil can by forcing the serrated jaws 13 against the “oil filter outer surface.” (Wendt at column 2, lines 58-59 and FIG. 2). This may be understood in the context of FIG. 2 of Wendt, an annotated portion of which is set forth below.



As is evident from the above figure, an oil can is “gripped” by squeezing the oil can between opposite sides of the jaws 11 and 12. Clearly, the *internal* surfaces of the oil can cannot be gripped by the jaws 11 and 12. Moreover, any such gripping would not form a *seal*.

Even if the device of Wendt is inserted into an acetabular liner and then the jaws 11 and 12 are spread such that the outer perimeters of the jaws are used to “grip” the liner (which does not appear to be a physically achievable feat given the shape of the outer

surfaces of the jaws 11 and 12 and the generally hemispherical shape of an acetabular liner), such a grip would not form a seal.

The Federal Circuit has stated:

Because the Hallmark of anticipation is prior invention, the prior art reference --in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements “arranged as in the claim.”

Net Moneyin, Inc. v. Verisign, Inc., 88 USPQ2d 1751, 1758, (Fed. Cir. 2008), citing, *Connell v Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983). Therefore, even if Wendt disclosed all of the elements of claim 1, the elements are not arranged in the manner required by claim 1. Consequently, Wendt does not anticipate claim 1 and the Board of Appeals is respectfully requested to reverse the rejection of claim 1.

4. The Piercing Jaw is Not a Head

Even if the Examiner intended to allege that the piercing jaw 20 of Wendt is a head, the piercing jaw 20 is not configured in the manner required by claim 1. As noted above, claim 1 requires the seal to form at the *inner* surface of the liner. The seal formed by the o-ring 21 at the base of the piercing jaw 20, however, is formed against the *outer* surface of the oil can, not the inner surface.

In fact, the piercing jaw 20 does not even *engage* the *inner* surface of the can. Specifically, as the oil can is punctured, the piercing jaw 20 deforms the oil can by bending the outer surface of the oil can inwardly. Once the outer surface of the oil can fractures, the piercing jaw 20 is still in contact with the deformed outer surface of the oil can which has been forced into the inner portion of the oil can. Thus, the piercing jaw 20,

although extending to the inner portion of the oil can, is still separated from contact with the inner surface of the oil can by the outer wall of the oil can.

Therefore, even if the piercing jaw 20 is considered to be a head, the elements are not arranged in the manner required by claim 1. Consequently, Wendt does not anticipate claim 1 and the Board of Appeals is respectfully requested to reverse the rejection of claim 1.

5. Wendt Cannot Seal Against an Inner Surface

The Examiner further generally alleges that Wendt “is capable of being used as claimed if one so desires to do so (sic)”. (Office Action at page 4). One cannot physically position the device of Wendt to form a seal on the inner surface of an acetabular liner.

Specifically, acetabular liners are generally hemispherical. The only manner in which the inner surface of a hemispherical object could be gripped with the device of Wendt is by inserting the jaw halves 11 and 12 within the hemispherical object and pressing the outer perimeter of the jaw halves 11 and 12 against the inner surface of the hemispherical object. This would create, at most, two opposing pressure points, with no sealing whatsoever between the jaw halves 11 and 12.

The Federal Circuit has stated that “[a] patent applicant is free to recite features of an apparatus either structurally or functionally. See In re Swinehart, 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971) (“[T]here is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims.”).” In re Schreiber, 44 USPQ 2d 1429, 1432 (Fed Cir. 1997). To the extent that the claimed

configuration of a head so as to form a seal on the inner surface of an acetabular liner is functional language, such functional language distinguishes claim 1 from the device of Wendt because the device of Wendt cannot form a seal on the inner surface of a hemispherical object.

Consequently, Wendt does not anticipate claim 1 and the Board of Appeals is respectfully requested to reverse the rejection of claim 1.

6. Conclusion

Anticipation of a claim under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Since Wendt does not disclose each and every element of Appellants' claim 1 for any of the reasons set forth above, Wendt does not anticipate Appellants' claim 1 and the Board of Appeals is respectfully requested to reverse the rejection of claim 1.

Discussion re: Patentability of Claims 4 and 8

Claims 4 and 8 depend directly from claim 1 and incorporate all the limitations of claim 1. Claims 4 and 8 were rejected based upon the same prior art discussed above with respect to claim 1. Accordingly, claims 4 and 8 are patentable over the prior art for at least the same reasons as those set forth above in connection with claim 1 and the Board of Appeals is respectfully requested to reverse the rejection of claims 4 and 8.

Discussion Re: Patentability of Claim 2 over Wendt

1. Claim 2

Claim 2 recites the following:

The instrument of claim 1, the head portion further comprising:

a first o-ring circumscribing the curvilinear outer perimeter of the head portion and sized to sealingly fit between the curvilinear outer perimeter of the head portion and an acetabular liner.

Claim 2 thus requires an o-ring to 1) extend around the perimeter of the head, and 2) be positioned between the outer perimeter of the head and the acetabular liner.

2. Argument of Claim 1 Applies

As an initial matter, claim 2 depends from claim 1 and includes all of the limitations discussed above with respect to claim 1. The Examiner rejected claim 2 based upon the same prior art discussed above with respect to claim 1. Accordingly, for the same reasons set forth above with respect to claim 1, claim 2 is patentable over Wendt.

3. Wendt's O-Ring is Not Configured as Claimed

The Examiner has rejected claim 2 based upon Wendt. (Office Action at page 3). The Examiner has mischaracterized Wendt.

Specifically, the Examiner alleges that the o-ring 21 is configured in the manner required by claim 2. (Office Action at page 3). As depicted in FIG. 3, the o-ring 21 of Wendt is positioned about the piercing jaw 20. Accordingly, if the piercing jaw 20 is considered to be a head, the o-ring 21 extends around the perimeter of the head as required by claim 2.

Claim 2 further requires, however, that the o-ring be configured to be positioned between the thing about which it extends (the head) and the inner surface of the acetabular liner. When the piercing jaw 20 pierces an oil can, the o-ring is pressed between the outer surface of the oil can and the wrench half 11 so as to form a seal. The wrench half 11 is not the piercing jaw 20. Therefore, the o-ring 20 is not between the thing about which it extends (the head) and the inner surface of the acetabular liner. A configuration which does not result in an o-ring being positioned between a head about which the o-ring extends and a surface of the object being held is not the same as a configuration which results in an o-ring being positioned between a head about which the o-ring extends and a surface of the object being held.

Therefore, because the o-ring of Wendt is not configured in the manner required by claim 2, Wendt does not anticipate claim 2. Accordingly, the Board of Appeals is respectfully requested to reverse the rejection of claim 2.

4. Conclusion

It is axiomatic that anticipation of a claim under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Since Wendt does not disclose each element of the Appellants' claim 2, for any or all of the foregoing reasons, Wendt does not anticipate Appellants' claim 2. Accordingly, the Board of Appeals is respectfully requested to overturn the rejection of claim 2.

Discussion Re: Patentability of Claim 11 over Wendt

1. Claim 11

Claim 11 recites the following:

The instrument of claim 1, wherein the head portion comprises an internal chamber communicating with the inner channel, and wherein the second end portion of the shaft sealingly fits within the internal chamber.

Claim 11 thus requires a shaft to extend into a chamber in the head.

2. Argument of Claim 1 Applies

As an initial matter, claim 11 depends from claim 1 and includes all of the limitations discussed above with respect to claim 1. The Examiner rejected claim 11 based upon the same prior art discussed above with respect to claim 1. Accordingly, for the same reasons set forth above with respect to claim 1, claim 11 is patentable over Wendt.

3. Examiner Has Failed to Identify or Allege a Chamber in Wendt

The Examiner has rejected claim 11 based upon Wendt. (Office Action at page 3). The Examiner has failed, however, to identify any structure or disclosure of Wendt which could be considered to be a chamber configured to receive a shaft as recited in claim 11. (See, e.g., Office Action at pages 3-4). Therefore, the Examiner has failed to even allege *prima facie* anticipation.

It is axiomatic that anticipation of a claim under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Since the Examiner has failed to even allege a structure or disclosure in Wendt with the characteristics of the

structure recited in claim 11, Wendt does not anticipate Appellants' claim 11 and the Board of Appeals is respectfully requested to reverse the rejection of claim 11.

4. Conclusion

It is axiomatic that anticipation of a claim under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Since Wendt does not disclose each element of the Appellants' claim 11, for any or all of the foregoing reasons, Wendt does not anticipate Appellants' claim 11. Accordingly, the Board of Appeals is respectfully requested to overturn the rejection of claim 11.

Discussion re: Patentability of Claim 25

1. Claim 25

Claim 25 recites the following:

An instrument for insertion of an acetabular liner into an acetabular cup comprising:
 a shaft having an internal channel therethrough and a first and a second end portion, the first end portion configured to sealingly engage with a hand held vacuum producing device; and
 a head having a curvilinear outer perimeter configured to abut a 360 degree portion of the inner surface of an acetabular liner and operably attached to the second end portion of the shaft and having an inner channel therethrough operably connected to the internal channel of the shaft.

Accordingly, claim 25 recites a device which seals around 360 degrees of the internal surface of an acetabular cup.

1. The Preamble Has Been Ignored

As discussed above, the Federal Circuit has stated that “[i]f the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the

claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim.” *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). The preamble of claim 25 is necessary to give life to the claim.

Specifically, the preamble of claim 25 specifies that the claimed system is “for insertion of an acetabular liner into an acetabular cup.” The entire specification is directed to the issue of how to provide for proper insertion of an acetabular liner given the constraints of a surgical environment. (See, e.g., Appellants’ specification at pages 2-4). Thus, the preamble establishes the context for the meaning of the limitations set forth therein.

Therefore, the instrument of claim 25 must be an instrument “for insertion of an acetabular liner into an acetabular cup.”

In contrast, the device of Wendt is configured to destroy an oil can so as to recover oil remaining therein. To this end, the device includes a “piercing jaw tooth” which punctures the oil can to allow oil to be recovered. One of ordinary skill in the art would never intentionally “puncture” an acetabular liner when inserting the liner. As discussed at page 1 of the Appellants’ specification, the acetabular liner provides a bearing surface for the ball or femoral component of the joint. A bearing surface which has been punctured is unsuitable for use in an acetabular cup.

Anticipation under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Since Wendt does not disclose a device that could be used “for insertion of an acetabular liner into an acetabular cup,” Wendt does not anticipate claim 25.

2. Examiner Has Failed to Properly Identify or Allege a Head in Wendt

The Examiner has rejected claim 25 based upon Wendt. (Office Action at page 3). The Examiner has failed, however, to properly identify any structure or disclosure in Wendt which could be considered to be a head as recited in claim 2. (See, e.g., Office Action at page 3).

Specifically, the Examiner has alleged that Wendt discloses “a head portion (see figure 2), which is capable of sealingly engaging the inner surface of an acetabular liner.” (Office Action at page 3). Figure 2, however, discloses the entire device of Wendt. Moreover, nothing in FIG. 2 of Wendt appears to be even remotely similar to the head 26 shown in Appellants’ FIG. 5. Likewise, nothing in figure 1 of Wendt is configured to sealingly engage the inner surface of a generally hemispherical object, which is the general shape of an acetabular liner.

37 CFR. 1.104 (c)(2) states

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Because the Examiner failed to identify any structure in figure 2 which disclosed a “head”, and because the entire device of Wendt is shown in FIG. 2, the Examiner has failed to comply with 37 CFR 1.104.

Because the Examiner has failed to comply with the requirements of 37 CFR. 1.104 (c)(2), the rejection of claim 25 under 35 U.S.C. § 102 is improper. Accordingly, the Board of Appeals is respectfully requested to reverse the rejection of claim 25.

3. The Wendt Device is Not Arranged as Required by Claim 25

Even if one assumes *arguendo* that the Examiner alleged that Wendt disclosed a device that included all of the structural limitations of claim 25, the elements of Wendt are not arranged in the manner required by claim 25.

Specifically, claim 25 requires a head with an outer perimeter that sealingly engages around 360 degrees of the *internal* surface of an acetabular liner. Thus, in addition to the discussion above regarding the failure of Wendt to disclose the arrangement of claim 1, no portion or portions of Wendt can contact 360 degrees of an inner surface of an acetabular liner. Therefore, even if Wendt disclosed all of the elements of claim 25, the elements are not arranged in the manner required by claim 25. Consequently, Wendt does not anticipate claim 25 and the Board of Appeals is respectfully requested to reverse the rejection of claim 25.

4. The Piercing Jaw is Not a Head

Even if the Examiner intended to allege that the piercing jaw 20 of Wendt is a head, the piercing jaw 20 is not configured in the manner required by claim 25. In addition to the discussion with respect to claim 1 above regarding the failure of the piercing jaw 20 to seal an inner surface, the piercing jaw 20 cannot contact about a 360 degree portion of an inner surface

Therefore, even if the piercing jaw 20 is considered to be a head, the elements are not arranged in the manner required by claim 25. Consequently, Wendt does not

anticipate claim 25 and the Board of Appeals is respectfully requested to reverse the rejection of claim 25.

5. Wendt Cannot Seal Against an Inner Surface

The Examiner further generally alleges that Wendt “is capable of being used as claimed if one so desires to do so (sic)”. (Office Action at page 4). One cannot physically position the device of Wendt to form a seal on the inner surface of an acetabular liner as discussed above with respect to claim 1, much less form a seal around a 360 degree portion of an inner surface. Consequently, Wendt does not anticipate claim 25 and the Board of Appeals is respectfully requested to reverse the rejection of claim 25.

6. Conclusion

Anticipation of a claim under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Since Wendt does not disclose each and every element of Appellants’ claim 25 for any of the reasons set forth above, Wendt does not anticipate Appellants’ claim 25 and the Board of Appeals is respectfully requested to reverse the rejection of claim 25.

Discussion re: Patentability of Claims 26 and 29

Claims 26 and 29 depend directly from claim 25 and incorporate all the limitations of claim 25. Claims 26 and 29 were rejected based upon the same prior art discussed above with respect to claim 25. Accordingly, claims 26 and 29 are patentable over the prior art for at least the same reasons as those set forth above in connection with

claim 25 and the Board of Appeals is respectfully requested to reverse the rejection of claims 26 and 29.

Discussion Re: Patentability of Claim 27 over Wendt

1. Claim 27

Claim 27 recites the following:

The instrument of claim 25, the head comprising:

a first groove circumscribing the curvilinear outer perimeter of the head; and
a first o-ring located within the first groove and sized to sealingly fit between the curvilinear outer perimeter of the head and an acetabular liner.

Claim 27 thus requires an o-ring to 1) extend around the perimeter of the head, and 2) be positioned between the outer perimeter of the head and the acetabular liner.

2. Argument of Claim 25 Applies

As an initial matter, claim 27 depends from claim 25 and includes all of the limitations discussed above with respect to claim 25. The Examiner rejected claim 27 based upon the same prior art discussed above with respect to claim 25. Accordingly, for the same reasons set forth above with respect to claim 25, claim 27 is patentable over Wendt.

2. Argument of Claim 2 Applies

Moreover, the limitations added by claim 27 are, for purposes of this appeal, the same limitations added by claim 2. The Examiner rejected claim 27 based upon the same prior art discussed above with respect to claim 2. Accordingly, for the same reasons set

forth above with respect to the limitation added by claim 2, claim 27 is patentable over Wendt.

4. Conclusion

It is axiomatic that anticipation of a claim under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Since Wendt does not disclose each element of the Appellants' claim 27, for any or all of the foregoing reasons, Wendt does not anticipate Appellants' claim 27. Accordingly, the Board of Appeals is respectfully requested to overturn the rejection of claim 27.

Discussion re: Patentability of Claim 30

Claim 30 depends directly from claim 27 and incorporates all the limitations of claim 27. Claim 30 was rejected based upon the same prior art discussed above with respect to claim 27. Accordingly, claim 30 is patentable over the prior art for at least the same reasons as those set forth above in connection with claim 27 and the Board of Appeals is respectfully requested to reverse the rejection of claim 30.

Claims 3 and 28 are not Obvious

Claims 3 and 28 stand rejected under 35 USC §103(a) as being obvious over Wendt in view of Baumann. The proposed modification fails to arrive at the claimed invention and the Examiner has failed to clearly articulate the reasons for the alleged obviousness of the invention. Therefore, the rejection should be overturned.

Discussion Re: Patentability of Claim 3 over Wendt and Bauman

1. Claim 3

Claim 3 recites the following:

The instrument of claim 2, the head portion further comprising:
a second o-ring circumscribing the curvilinear outer perimeter of the head portion and adjacent the first o-ring, and
a secondary inner channel having a first and a second end portion and operably connected at the first end portion to the internal channel and opening at the second end portion at the outer perimeter of the head portion between the first and second o-ring.

Accordingly, claim 3 recites two o-rings which both encircle the *same* perimeter and a second channel in the head that is in communication with the channel in the shaft.

2. Argument of Claim 2 Applies

As an initial matter, claim 3 depends from claim 2 and includes all of the limitations of claim 2. The Examiner rejected claim 3 based upon the same prior art discussed above with respect to claim 2 with further reference to Baumann for the limitations added by claim 3. Such further modification of Wendt fails to correct the deficiencies of Wendt with respect to the limitations of claim 2 as discussed above. Accordingly, for the same reasons set forth above with respect to claim 2, claim 3 is patentable over the combination of Wendt and Baumann.

3. Baumann does Not Disclose the O-ring Configuration of Claim 3

The Examiner has alleged that Baumann discloses a second o-ring. (Office Action at page 5). Baumann does not disclose a second o-ring with the characteristics required by claim 3.

Specifically, the Examiner has alleged that the “two o-rings/grooves/channels, e.g. 5 and 6” of Baumann are configured in the manner required by claim 3. As depicted in the figure of Baumann, the o-rings 5 and 6 are on *different* surfaces of the locking ring 3, neither one of which is an *outer* perimeter. Two o-rings on different internal surfaces of a locking ring are not the same as two o-rings on the *same outer perimeter* of a head.

Therefore, because claim 3 requires two o-rings on the *same* perimeter, and because Baumann fails to disclose such a configuration, even if Wendt is modified to incorporate a second o-ring as disclosed by Baumann, such modification fails to arrive at the invention of claim 3.

4. Baumann does Not Disclose the Channel Configuration of Claim 3

The Examiner has alleged that Baumann discloses a second channel. (Office Action at page 5). Baumann does not disclose a second channel with the characteristics required by claim 3.

Specifically, the Examiner has alleged that the “two o-rings/grooves/channels, e.g. 5 and 6” of Baumann are configured in the manner required by claim 3. As depicted in the figure of Baumann, the o-rings 5 and 6 are positioned in two different grooves with extend about internal surfaces of the locking ring 3. Neither of the o-ring channels, however, are in communication with a channel in a shaft, such as might be depicted by the un-shaded area in the middle of Baumann’s joint ball 1. A channel that is isolated from an internal channel is not the same as a channel that is *connected to* an internal channel.

Therefore, because claim 3 requires a second channel that opens to an internal channel of a shaft, and because Baumann fails to disclose such a configuration, even if Wendt is modified to incorporate a second channel as allegedly disclosed by Baumann, such modification fails to arrive at the invention of claim 3.

5. Reasons for Obviousness Have Not Been Clearly Articulated

The Examiner argues that modification of Wendt with the teaching of Baumann to arrive at the invention of claim 3 is established “for proper sealing of the two leak paths in Baumann, analogous to the instant application.” (Office Action at page 5). The Examiner thus argues that because Baumann includes two leak paths, which apparently refers to the existence of the second O-ring channel, a second o-ring would be provided. The Examiner has failed to provide an explanation however, of why one of ordinary skill in the art would add a “second leak path,” merely so as to be able to use a second o-ring. Therefore, the Examiner has failed to provide a clear articulation of why modifying Wendt with the teaching of Baumann would be obvious.

MPEP 2142 notes that “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.” Because the Examiner has failed to provide a clear articulation explaining why changing the configuration of Wendt to one which reads upon claim 3 would be obvious, a *prima facie* case of obviousness has not been established with respect to claim 3.

6. Conclusion

For any or all of the foregoing reasons, the Appellants respectfully submit that claim 3 is not obvious over Wendt in view of Baumann. Accordingly, the Board of Appeals is respectfully requested to overturn the rejection of claim 3.

Discussion Re: Patentability of Claim 28 over Wendt and Bauman

1. Claim 28

Claim 28 recites the following:

The instrument of claim 27, the head further comprising:
 a second groove circumscribing the curvilinear outer perimeter of the head and adjacent the first groove;
 a second o-ring located within the first groove; and
 a secondary inner channel having a first and a second end portion and operably connected at the first end portion to the internal channel and opening at the second end portion at the outer perimeter of the head between the first and second groove.

Accordingly, claim 28 recites two o-rings which both encircle the *same* perimeter, two o-ring grooves, and a second channel in the head that is in communication with the channel in the shaft.

2. Argument of Claim 27 Applies

As an initial matter, claim 28 depends from claim 27 and includes all of the limitations of claim 27. The Examiner rejected claim 28 based upon the same prior art discussed above with respect to claim 27 with further reference to Baumann for the limitations added by claim 28. Such further modification of Wendt fails to correct the deficiencies of Wendt with respect to the limitations of claim 27 as discussed above.

Accordingly, for the same reasons set forth above with respect to claim 27, claim 28 is patentable over the combination of Wendt and Baumann.

3. Baumann does Not Disclose the O-ring Configuration of Claim 28

Claim 28 recites a second o-ring which, for purposes of this appeal, is the same second o-ring as the o-ring discussed above with respect to claim 3. Accordingly, for the same reasons set forth above with respect to the second o-ring of claim 3, the proposed modification fails to arrive at the invention of claim 28.

4. Baumann does Not Disclose the Channel Configuration of Claim 28

Claim 28 recites a second channel which, for purposes of this appeal, is the same second channel as the channel discussed above with respect to claim 3. Accordingly, for the same reasons set forth above with respect to the second channel of claim 3, the proposed modification fails to arrive at the invention of claim 28.

5. Reasons for Obviousness Have Not Been Clearly Articulated

The Examiner used the same argument in explaining the obviousness of claim 28 that was used with respect to claim 3. Accordingly, for the same reasons set forth above with respect to the articulation of the alleged obviousness of claim 3, the alleged obviousness of claim 28 has not been clearly articulated.

6. Conclusion

For any or all of the foregoing reasons, the Appellants respectfully submit that claim 28 is not obvious over Wendt in view of Baumann. Accordingly, the Board of Appeals is respectfully requested to overturn the rejection of claim 28.

Claims 5-7 are not Obvious

Claims 5-7 stand rejected under 35 USC §103(a) as being obvious over Wendt in view of Skow. The proposed modification fails to arrive at the claimed invention and the Examiner has failed to clearly articulate the reasons for the alleged obviousness of the invention. Therefore, the rejection should be overturned.

Specifically, claims 5-7 depend from claim 1 and include all of the limitations of claim 1. The Examiner rejected claims 5-7 based upon the same prior art discussed above with respect to claim 1 with further reference to Skow for the limitations added by claims 5-7. (Office Action at page 5). Such further modification of Wendt fails to correct the deficiencies of Wendt with respect to the limitations of claim 1 as discussed above. Accordingly, for the same reasons set forth above with respect to claim 1, claims 5-7 patentable over the combination of Wendt and Skow.

Moreover, the Examiner argues that proposed modification is obvious because a benefit would be achieved. Namely, “to prevent liquid from exiting the valve until a predetermined amount of pressure is provided by bulb actuation.” (Office Action at page 5). That same effect, of course, is obtained by closing the first valve such that no fluid passes through the first valve until a predetermined amount of pressure is provided by bulb actuation. The Examiner has failed to explain, however, what role a second valve

would play or why one would not merely use the single valve of Wendt to control the flow of oil through the valve, particularly since Wendt provides the valve for exactly that reason. (Wendt at column 3, lines 13-15). Therefore, the Examiner has failed to provide a clear articulation of why modifying Wendt with the teaching of Skow would be obvious.

MPEP 2142 notes that “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.” Because the Examiner has failed to provide a clear articulation explaining why changing the configuration of Wendt to one which reads upon claims 5-7 would be obvious, a *prima facie* case of obviousness has not been established with respect to claims 5-7.

Accordingly, claims 5-7 are patentable over the art cited by the Examiner for any of the foregoing reasons and the Board of Appeals is respectfully requested to overturn the rejection of claims 5-7.

Claims 9 and 10 are not Obvious

Claims 9 and 10 stand rejected under 35 USC §103(a) as being obvious over Wendt. Claims 9 and 10 depend from claim 8 and include all of the limitations of claim 8. The Examiner rejected claims 9 and 10 based upon the same prior art discussed above with respect to claim 8 with further reference to optimization for the limitations added by claims 9 and 10. Such further modification of Wendt fails to correct the deficiencies of

Wendt with respect to the limitations of claim 8 as discussed above. Accordingly, for at least the same reasons set forth above with respect to claim 8, claims 9 and 10 are patentable over the proposed modification of Wendt.

Claims 20-22 are not Obvious

Claims 20-22 stand rejected under 35 USC §103(a) as being obvious over Wendt in view of Sweeney. The proposed modification fails to arrive at the claimed invention and the Examiner has failed to clearly articulate the reasons for the alleged obviousness of the invention. Therefore, the rejection should be overturned.

Discussion re: Patentability of Claim 20

1. Claim 20

Claim 20 recites the following:

A kit providing a handheld instrument for insertion of an acetabular liner into an acetabular cup comprising:

a shaft having an internal channel therethrough and a first and a second end portion, the first end portion configured to sealingly engage with a bulb syringe, the second end configured to sealingly engage with a head; and

a plurality of heads, each head having a curvilinear outer perimeter and configured to be operably attached to the second end portion of the shaft such that an inner channel of the head connects to the internal channel of the shaft, each of the plurality of heads having a curvilinear outer perimeter sized to at least partially fit within an acetabular liner.

Accordingly, claim 20 recites a kit with multiple heads with channels that receive a shaft and which fit within an acetabular cup.

1. The Preamble Has Been Ignored

As discussed above, the Federal Circuit has stated that “[i]f the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is ‘necessary to give life, meaning, and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the claim.” *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). The preamble of claim 20 is necessary to give life to the claim.

Specifically, the preamble of claim 20 specifies that the claimed kit is “for insertion of an acetabular liner into an acetabular cup.” The entire specification is directed to the issue of how to provide for proper insertion of an acetabular liner given the constraints of a surgical environment. (See, e.g., Appellants’ specification at pages 2-4). Thus, the preamble establishes the context for the meaning of the limitations set forth therein. Moreover, the heads in the kit of claim 20 are “sized to at least partially fit within an acetabular liner.”

Therefore, the kit of claim 20 must be one which is used “for insertion of an acetabular liner into an acetabular cup.”

In contrast, the device of Wendt is configured to destroy an oil can so as to recover oil remaining therein. To this end, the device includes a “piercing jaw tooth” which punctures the oil can to allow oil to be recovered. One of ordinary skill in the art would never intentionally “puncture” an acetabular liner when inserting the liner. As discussed at page 1 of the Appellants’ specification, the acetabular liner provides a bearing surface for the ball or femoral component of the joint. A bearing surface which has been punctured is unsuitable for use in an acetabular cup.

Accordingly, even if Wendt is modified in the manner proposed by the Examiner, such modification fails to arrive at the invention of claim 20 and the Board of Appeals is respectfully requested to reverse the rejection of claim 20.

2. Examiner Has Failed to Identify or Allege a Shaft in Wendt

The Examiner has rejected claim 20 based primarily upon Wendt with further reference to Sweeney for teaching the incorporation of multiple objects in a kit. (Office Action at page 6). The Examiner has failed, however, to identify any structure or disclosure in Wendt which could be considered to be a shaft as recited in claim 20. (See, e.g., Office Action at page 6). Therefore, the Examiner has failed to even allege *prima facie* obviousness.

Since the Examiner has failed to even allege that Wendt includes a shaft as recited in claim 20, modification of Wendt to include a plurality of heads does not arrive at the invention of Appellants' claim 20 and the Board of Appeals is respectfully requested to reverse the rejection of claim 20.

3. Examiner Has Failed to Identify or Allege a Head in Wendt

As discussed above, the Examiner has rejected claim 20 based primarily upon Wendt with further reference to Sweeney for teaching the incorporation of multiple objects in a kit. (Office Action at page 6). The Examiner has failed, however, to identify any structure or disclosure in Wendt which could be considered to be a head as recited in claim 20. (See, e.g., Office Action at page 6). Therefore, the Examiner has failed to even allege *prima facie* obviousness.

Since the Examiner has failed to even allege that Wendt includes a head as recited in claim 20, modification of Wendt to include a plurality of such heads does not arrive at the invention of Appellants' claim 20 and the Board of Appeals is respectfully requested to reverse the rejection of claim 20.

4. The Wendt Device is Not Arranged as Required by Claim 20

Even if one assumes *arguendo* that the Examiner alleged that Wendt disclosed a device with a head, the elements of Wendt are not arranged in the manner required by claim 20.

Specifically, claim 20 requires a plurality of heads, each of which can be attached to a shaft. Wendt, however, fails to disclose any portion of the oil filter wrench 10, which could even arguably be a head, which can be attached to a shaft. By way of example, the components most likely to be alleged to be a head are the wrench half 11 or the piercing jaw 20, both of which are shown as permanently attached to the rest of the wrench. Therefore, even if Wendt disclosed all of the elements of claim 20, the elements are not arranged in the manner required by claim 20. Consequently, the proposed modification fails to arrive at the invention of claim 20 and the Board of Appeals is respectfully requested to reverse the rejection of claim 20.

5. Reasons for Obviousness Have Not Been Clearly Articulated

The Examiner argues that modification of Wendt with the teaching of Sweeney to arrive at the invention of claim 20 is established "to allow the surgeon to select an appropriate insert based on the particular needs of the patient." (Office Action at page 6).

The Examiner appears to disregard the fact that Wendt already provides a device configured for use with differently sized objects. Specifically, the wrench halves 11 and 12 pivot with respect to one another, allowing the wrench halves 11 and 12 to be pivoted toward and away from one another. (See, e.g., Wendt at FIG. 1). Moreover, the slip joint adjustment 14 “is provided to allow the wrench to be used for smaller or larger oil filter sizes as needed.” (Wendt at column 2, lines 59-61 and FIG. 1). The Examiner has failed to provide an explanation of why one of ordinary skill in the art would find the adjustment mechanism of Wendt to be inadequate and to further modify the device of Wendt in some non-alleged manner to allow some non-alleged component to be selectively positioned on another non-alleged to provide adjustments in a different manner. Therefore, the Examiner has failed to provide a clear articulation of why modifying Wendt in the alleged fashion would be obvious.

MPEP 2142 notes that “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.” Because the Examiner has failed to provide a clear articulation explaining why changing the configuration of Wendt to one which reads upon claim 20 would be obvious, a *prima facie* case of obviousness has not been established with respect to claim 20.

6. Conclusion

For any or all of the foregoing reasons, the Appellants respectfully submit that claim 20 is not obvious over Wendt in view of Sweeney. Accordingly, the Board of Appeals is respectfully requested to overturn the rejection of claim 20.

Discussion re: Patentability of Claims 21 and 22

Claims 21 and 22 depend directly from claim 20 and incorporate all the limitations of claim 20. Claims 21 and 22 were rejected based upon the same prior art discussed above with respect to claim 20. Accordingly, claims 21 and 22 are patentable over the prior art for at least the same reasons as those set forth above in connection with claim 20 and the Board of Appeals is respectfully requested to reverse the rejection of claims 21 and 22.

Claims 23-24 are not Obvious

Claims 23-24 stand rejected under 35 USC §103(a) as being obvious over Wendt in view of Sweeney. Claims 23-24 depend from claim 20 and include all of the limitations of claim 20. The Examiner rejected claims 23-24 based upon the same prior art discussed above with respect to claim 20 with further reference to optimization for the limitations added by claims 23-24. Such further modification of Wendt fails to correct the deficiencies of Wendt and Sweeney with respect to the limitations of claim 20 as discussed above. Accordingly, for the same reasons set forth above with respect to claim 20, claims 23-24 are patentable over the proposed modification of Wendt.

CONCLUSION

Claims 1, 2, 4, 8, 11, 25-27, and 29-30 are not anticipated by Wendt, claims 3 and 28 are not obvious over Wendt in view of Baumann, claims 5-7 are not obvious over Wendt in view of Skow, claims 9 and 10 are not obvious over Wendt, claims 20-22 are not obvious over Wendt in view of Sweeney, and claims 23-24 are not obvious over Wendt in view of Sweeney. Accordingly, the Board of Appeals is respectfully requested to reverse the rejections of claims 1-11 and 20-30.

Respectfully submitted,
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(8) CLAIMS APPENDIX

Claim 1. A handheld instrument for insertion of an acetabular liner into an acetabular cup comprising:

a shaft having an internal channel therethrough and a first and a second end portion, the first end portion configured to sealingly engage with a bulb syringe;

a bulb syringe sealingly engaged with the first end portion of the shaft and operably connected to the internal channel of the shaft; and

a head portion having a curvilinear outer perimeter configured to sealingly engage the inner surface of an acetabular liner and operably attached to the second end portion of the shaft and having an inner channel therethrough operably connected to the internal channel of the shaft.

Claim 2. The instrument of claim 1, the head portion further comprising:

a first o-ring circumscribing the curvilinear outer perimeter of the head portion and sized to sealingly fit between the curvilinear outer perimeter of the head portion and an acetabular liner.

Claim 3. The instrument of claim 2, the head portion further comprising:

a second o-ring circumscribing the curvilinear outer perimeter of the head portion and adjacent the first o-ring, and

a secondary inner channel having a first and a second end portion and operably connected at the first end portion to the internal channel and opening at the second end portion at the outer perimeter of the head portion between the first and second o-ring.

Claim 4. The instrument of claim 1 further comprising a valve, the valve operable to seal the internal channel such that air is not allowed to pass between the atmosphere and the internal channel through the valve.

Claim 5. The instrument of claim 1, further comprising:

a stop check valve having an inlet and an outlet, the inlet operably connected to the internal channel and the outlet operably connected to the atmosphere, such that when the stop check valve is in a non-stopped position, air from the atmosphere is not allowed to pass into the internal channel through the stop check valve but air from the internal channel is allowed to pass to the atmosphere through the stop check valve and such that when the stop check valve is in a stopped position, air from the internal channel is not allowed to pass into the atmosphere through the stop check valve; and

a valve movable between a first position and a second position and having an inlet and an outlet, the inlet operably connected to the atmosphere and the outlet operably connected to the bulb syringe, such that when the valve is in the first position, air is not allowed to pass between atmosphere and the internal channel, and when the valve is in the second position, air is allowed to pass between the atmosphere and the internal channel.

Claim 6. The instrument of claim 5, wherein the sealable valve is a stop check valve.

Claim 7. The instrument of claim 5, wherein the stop check valve is located on the bulb syringe, such that air passing between the inner channel and the atmosphere through the stop check valve passes through the bulb syringe.

Claim 8. The instrument of claim 1, wherein the shaft is bent between the first end portion and the second end portion.

Claim 9. The instrument of claim 8, wherein the shaft comprises a bend of between about 20 and about 45 degrees between the first end portion and the second end portion.

Claim 10. The instrument of claim 9, wherein the shaft comprises a bend of about 30 degrees between the first end portion and the second end portion.

Claim 11. The instrument of claim 1, wherein the head portion comprises an internal chamber communicating with the inner channel, and wherein the second end portion of the shaft sealingly fits within the internal chamber.

Claim 20. A kit providing a handheld instrument for insertion of an acetabular liner into an acetabular cup comprising:

a shaft having an internal channel therethrough and a first and a second end portion, the first end portion configured to sealingly engage with a bulb syringe, the second end configured to sealingly engage with a head; and

a plurality of heads, each head having a curvilinear outer perimeter and configured to be operably attached to the second end portion of the shaft such that an inner channel of the head connects to the internal channel of the shaft, each of the plurality of heads having a curvilinear outer perimeter sized to at least partially fit within an acetabular liner.

Claim 21. The kit of claim 20, further comprising:

a bulb syringe configured to sealingly engage the first end portion of the shaft and operably connect to the internal channel of the shaft.

Claim 22. The kit of claim 20, wherein each of the plurality of heads has an outer perimeter of a size different than the size of each of the other plurality of heads.

Claim 23. The kit of claim 20, wherein the plurality of heads comprises a first head, a second head and a third head, the first head having a curvilinear outer perimeter sized to at least partially fit within a 26 mm diameter acetabular liner, the second head having a curvilinear outer perimeter sized to at least partially fit within a 28 mm diameter

acetabular liner, and the third head having a curvilinear outer perimeter sized to at least partially fit within a 32 mm diameter acetabular liner.

Claim 24. The kit of claim 20, wherein the plurality of heads comprises:

a first head having a curvilinear outer perimeter sized to at least partially fit within a first acetabular liner having a first diameter; and

a second head having a curvilinear outer perimeter sized to at least partially fit within a second acetabular liner having a second diameter, the first diameter different from the second diameter, and wherein the first acetabular liner and the second acetabular liner have diameters of 26 mm, 28 mm, 32 mm, 36 mm or 38 mm.

Claim 25. An instrument for insertion of an acetabular liner into an acetabular cup comprising:

a shaft having an internal channel therethrough and a first and a second end portion, the first end portion configured to sealingly engage with a hand held vacuum producing device; and

a head having a curvilinear outer perimeter configured to abut a 360 degree portion of the inner surface of an acetabular liner and operably attached to the second end portion of the shaft and having an inner channel therethrough operably connected to the internal channel of the shaft.

Claim 26. The instrument of claim 25, wherein the head is configured to sealingly fit within an acetabular liner.

Claim 27. The instrument of claim 25, the head comprising:

- a first groove circumscribing the curvilinear outer perimeter of the head; and
- a first o-ring located within the first groove and sized to sealingly fit between the curvilinear outer perimeter of the head and an acetabular liner.

Claim 28. The instrument of claim 27, the head further comprising:

- a second groove circumscribing the curvilinear outer perimeter of the head and adjacent the first groove;
- a second o-ring located within the first groove; and
- a secondary inner channel having a first and a second end portion and operably connected at the first end portion to the internal channel and opening at the second end portion at the outer perimeter of the head between the first and second groove.

Claim 29. The instrument of claim 25 wherein the hand held vacuum producing device is a syringe.

Claim 30. The instrument of claim 27, wherein the syringe is a bulb syringe.

(9) EVIDENCE APPENDIX

None.

(10) RELATED PROCEEDINGS APPENDIX

None.